

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

Claims 7 and 12-25 are pending in this application. Claims 7 and 18 are the only independent claims.

Applicant appreciates the courtesies shown to Applicant's representative by Examiner Kashnikow during the September 15, 2010 personal interview. The reasons warranting favorable action discussed during the interview are incorporated into the following remarks and constitute Applicant's separate record of the interview.

The Official Action first rejects Claim 20 under 35 U.S.C. §112, first paragraph. In particular, the Official Action is of the opinion that the subject matter of Claim 20 is not discussed in the original specification. The rejection is respectfully traversed.

Claim 20 defines that the joining of the cut end face of the first web-form support layer to the cut end of a second web-form support layer is performed during the printing of the container design. As explained during the interview, these features are discussed in lines 2-6 on page 22 of the specification as filed. Thus, Claim 20 complies with the written description requirement. Withdrawal of the rejection is respectfully requested.

Independent Claims 7 and 18 stand rejected under 35 U.S.C. §103(a) in view of the combination of U.S. Patent No. 5,993,593 to Swartz et al. ("Swartz"), U.S. Patent No. 6,044,628 to Katayama et al. ("Katayama") and U.S. Patent No. 4,007,078 to Aoki et al. ("Aoki"). The rejection is respectfully traversed.

Independent Claim 7 recites a process of producing a web-form laminated material used for packaging containers. The process includes, *inter alia*, sealing the

trailing end of a web-form support layer to the leading end of a second web-form support layer by carrying out sealing of a conductive layer thereby forming a longer web-form support layer.

The process defined in independent Claim 18 includes joining a cut end face of a first web-form support layer to a cut end of a second web-form support layer, and sealing the cut end the first web-form support layer to the cut end of the second web-form support layer by carrying out sealing of the conductive layer.

The Official Action acknowledges that the combination of Swartz and Katayama fails to disclose these aspects of independent Claims 7 and 18, but takes the position that they are disclosed by Aoki. However, as discussed during the interview, that position is factually incorrect.

The method disclosed by Aoki supplies a plastic film strip B' from an extruder A to a winding device F and/or a bag making machine G as shown in Fig. 1 of Aoki. As discussed in lines 55-61 of column 4 of Aoki, the film strip B' is fed through a switching mechanism E to the winding device F via passage X where the film strip B' is wound around a winding drum 18 until the film strip B' has a predetermined thickness and breadth (see Fig. 1 of Aoki). When the winding operation performed by the winding device F is stopped, the film strip B' is cut by a heat cutting wire 43 as discussed in lines 58-68 of column 4 of the patent. Thereafter, the cut film strip B' is fed via the switching mechanism E to the bag making machine G (see lines 4-7 of column 5 of Aoki).

If, however, a coupling film strip B" is beforehand loaded on the bag making machine G, a different operation is performed after the film strip B' is wound around the winding device F. In this operation, **before** the film strip B' extending from the extruder A is cut, the rearward end of the film strip B" is passed through a second

passage Y in the switching mechanism E as shown in Fig. 3 of Aoki (see col. 5, lines 8-13 of Aoki). The rearward end of the film strip B" is then heat sealed to the film strip B' by the heat-sealer 15 as discussed in lines 21-28 in column 5 of Aoki. **After** the rearward end of the coupling strip B" has been joined to the film strip B' under the heat-sealer 15 while the film strip B' extends from the extruder A to the winding device F, the portion of the strip B' extending to the winding device F is subsequently cut (see col. 5, lines 28-32 of Aoki). The other portion of the film strip B', which is coupled with the strip B" and continuously supplied from extruder A, is fed to the bag making machine G through the second passage Y as discussed in lines 28-38 of column 5 of Aoki.

That is, as discussed during the interview, Aoki discloses that the rearward end of a film strip B" is heat sealed to the film strip B' at the heat sealer 15 *while the film strip B' extends from an extruder A to a winding device F*. In other words, the rearward end of the film strip B" is heat sealed to the film strip B' **before** the film strip B' is cut. Therefore, as discussed during the interview, the rearward end of the film strip B" is heat sealed to a *mid-portion* (i.e., a portion between the leading and trailing ends) of the film strip B'. The rearward end of the film strip B" is not heat sealed to the *leading end* of the film strip B' as defined in independent Claim 7.

During the interview, the Examiner referred to Claim 1 of Aoki. In particular, the Examiner referred to the portion of Aoki's Claim 1 in lines 60-63 of column 6. Here, Aoki's Claim 1 recites heat-sealing the trailing end portion of the previously wound imperfect film strip [i.e., the cut film strip B' wound by winding device F] to the leading end portion of the newly extruded imperfect film strip [i.e., the film strip B" extending from the extruder A to the bag making machine G] at the heat-sealing location. However, the "leading end portion" of the newly extruded imperfect film

strip, i.e., film strip B", is not the same as the claimed *leading end* of a second web-form support layer. This is because the next part of Aoki's Claim 1 (in lines 63-67 of column 6) recites severing the perfect film strip [i.e., the film strip B"] previously supplied to the processing machine [i.e., the bag making machine G] along the second perfect film strip passage [i.e., passage Y shown in Fig. 4 of Aoki], at a location between the heat-sealing location and the second perfect film strip passage [i.e., passage Y]. In other words, the trailing end portion of the film strip B' wound by winding device F is joined to the film strip B" *while the film strip B" is extending from the extruder A to the bag making machine G* (i.e., to a mid-portion of the film strip B") as shown in Fig. 4 of Aoki. As discussed in lines 63-67 of column 6 of Aoki's Claim 1, after the film strip B' is joined to the film strip B" extending from the extruder A to the bag making machine G, the film strip B" extending from the extruder A to the bag making machine G (i.e., the "perfect film strip previously supplied to the processing machine") is severed at the second perfect film strip passage Y.

Accordingly, as discussed during the interview, neither the description/drawings nor Claim 1 of Aoki provides an *enabling disclosure* of the claimed combination of features (see MPEP §2121(III) and MPEP §2121.01). Moreover, as discussed during the interview, the Official Action's reliance on Aoki's Claim 1 is legally incorrect. The reason is because the Official Action improperly treats the scope of a patent claim as a prior art disclosure. The Federal Circuit has made clear that the two are quite different, and that the scope of a patent claim cannot be relied upon as a patentability-defeating disclosure in the patent. *In re Benno*, 226 U.S.P.Q. 683, 686 (Fed. Cir. 1985) ("the scope of a patent's claims determines what infringes the patent; it is no measure of what it discloses").

Thus, as discussed during the interview, the combination of Swartz, Katayama and Aoki does not disclose, and would not have rendered obvious, the combination of features recited in independent Claim 7, including sealing the trailing end of a web-form support layer to the leading end of a second web-form support layer by carrying out sealing of a conductive layer thereby forming a longer web-form support layer. Therefore, independent Claim 7 is patentable over the combination of Swartz, Katayama and Aoki for at least the above reasons.

Further, for at least the reasons discussed above, Aoki does not disclose joining a *cut end face* of a first web-form support layer to a *cut end* of a second web-form support layer as defined in independent Claim 18. For example, Aoki discloses that after the rearward end of the coupling strip B" has met the film strip B' under the heat-sealer 15, the heat-sealer 15 is moved downwardly to press the two **overlapped** strips B' and B" against the surface of table 14 to heat-sealing the strips to each other (see col. 5, lines 21-28). Therefore, independent Claim 18 is patentable over the combination of Swartz, Katayama and Aoki for at least these reasons.

Claims 12-17 and 19-25 are patentable over the applied references at least by virtue of their dependence from the patentable independent claims. Thus, a detailed discussion of the additional distinguishing features recited in these dependent claims is not set forth at this time. Withdrawal of the rejections is respectfully requested.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

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